

REMARKS

Status of the Claims

Claims 1-41 are pending in this application.

Claims 1-21, 23-25 and 27-41 are currently under examination.

Claims 1 and 27 are amended herein; claims 42 and 43 are newly added.

No new matter is introduced.

Support for Claim Amendments

Independent method claims 1 and 27 are amended to include the limitation that “said area of skin is not affected by acne.” This negative (exclusionary) limitation finds support throughout the application as filed in the alternative recitation of various skin conditions including acne. It is well established that “[i]f alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.” MPEP § 2173.05(i); see also In re Johnson, 558 F.2d 1008 (CCPA 1977).

Claim 1 of the original disclosure, for example, recites “a condition selected from the group consisting of skin requiring desquamation, nail disorders, dandruff, calluses, acne, excess sebum production, enlarged skin pore size, and blackheads.” This Markush group is, by definition, a recitation of alternative elements including acne. See MPEP § 2173.05(h) (“One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being ‘selected from the group consisting of A, B and C’”). Similar alternative recitations are found in the description, for example, on page 1, lines 7–10 wherein it is disclosed that the “invention provides a method for treating nail disorders, dandruff, callus, accelerated sebum production, enlarged pores, blackheads, acne or skin requiring desquamation.” This “‘or’ terminology” is also, by definition, a recitation of alternative elements, one of which is acne. See MPEP § 2173.05(h) (“Alternative expressions using ‘or’ are acceptable, such as ‘wherein R is A, B, C, or D’”).

Thus, having positively recited acne as one alternative embodiment, there is support for excluding acne from the present claims by negative limitation. Accordingly, Applicants submit that the limitation “said area of skin is not affected by acne” does not introduce new matter.

Claim Rejections

35 U.S.C. §103(a)

The Examiner has rejected claims 1-7, 23-25 and 27-34 under 35 U.S.C. § 103(a) as allegedly obvious over Beerse et al. (U.S. Patent No. 6,294,186), in view of Duennenberger et al. (U.S. Patent No. 3,708,527), Perricone (U.S. Patent No. 6,743,433), and Wiegand et al. (U.S. Patent Pub. 2002/0151527). The Examiner contends that the claimed method of treating enlarged pores with halo-salicylic acid is obvious because “treating acne with halogen substituted salicylic acid” is allegedly “an old and well know method,” the practice of which the Examiner alleges would inherently reduce pore size because enlarged pores are “associated with acne.”

Applicants disagree with the Examiner’s contention that the term “enlarged pores” reads on the microcomedo lesions of acne. The application clearly identifies enlarged pores as distinct from acne and one skilled in the art reading the instant application would not have considered acne to constitute the enlarged pores of the instant claims. Nevertheless, Applicants submit that the rejection is overcome by the present amendments to independent claims 1 and 27 which specify that the area of skin to be treated “is not affected by acne.” Even assuming for the sake of argument that one skilled in the art would have been motivated to apply halosalicylic acids for the treatment of acne, there would have been no motivation to do the same to skin having enlarged pores in the absence of acne.

Accordingly, Applicants respectfully submit that the rejection is overcome by the present amendments. Having distinguished the independent claims, Applicants submit that the claims dependent therefrom are patentable for at least the same reasons. However, Applicants reserve the right to separately address the patentability of the dependent claims in the future, should that be necessary.

CONCLUSION

Applicants respectfully submit that the instant application is in condition for allowance. Entry of the amendments and an action passing this case to issue is therefore respectfully requested. In the event that a telephone conference would facilitate examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.


AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 50-3732, Order No. 03814-105024. Furthermore, in the event that a further extension of time is required, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-noted Deposit Account No. 50-3732 and Order No. 03814-105024.

Respectfully submitted,

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By: _____


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